FILE

Supreme Court of the United States

No. 742

PETITIONER'S REPLY TO RESPONDENT'S BRIEF IN OPPOSITION

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960.

No. 742.

DEERE & COMPANY,

Petitioner,

vs.

JOHN W. ENGLAND,

Respondent.

PETITIONER'S REPLY TO RESPONDENT'S BRIEF IN OPPOSITION.

The Brief for Respondent in Opposition completely avoids the issues presented by petitioner.

Petitioner's first question presented for review is as follows (Petition, Page 2):

> "1. Can a patentee, desiring narrower claims by reissue, avoid admission that he was claiming more than he had a right to claim in the original patent by making superfluous insertions in the specification in alleged correction of defects there?"

Respondent, of course, does not dare to reply in the affirmative; and, significantly, neither does he deny that his insertions in the specification, in alleged correction of defects there, are superfluous.

What respondent does, under "Questions Presented" on Page 2 of his brief, is to present his own version as follows:

> "2. Whether the Patent Office's reissue of respond-

ent's patent with the retention of the original claims and added narrower claims was legal."

Respondent thus places the onus on the Patent Office, and we, notwithstanding, answer in the negative, pointing out that the originating responsibility is respondent's own.

Copy of the reissue patent in suit is at Pages 119-122 of the Appendix to Brief for Defendant-Appellant, and, for the convenience of the Court, a reproduction is bound in the end of this Brief. In accordance with the Patent Office Rules, inserts are printed in italics, and the artificiality of those in the specification (lines 62 and 63 of Column 1 and lines 6-8 of Column 2) is manifest on their face. As stated in the Petition, Page 15, they would not be permitted unless the drawings spoke for themselves, and, if they were not there, there would be no defect; and hence no defect in the original specification.

The underlying reissue statute, 35 U. S. C. 251, provides only the following bases for reissue:

(a) a defective specification or drawing; and
(b) a patentee claiming more or less than he had a right to claim.

In the case at bar, respondent's original patent did not, in truth, qualify under (a), and, since the claims added by reissue were declared to be narrower than the original claims,* the only basis for reissue could have been under (b), invalidity on the ground of claiming more than the patentee had a right to claim.

This Court, in *McCormick Machine Co.* v. *Aultman*, 169 U. S. 606, referring to the predecessor reissue statute R. S. 4916, said at Page 610:

"The plain purpose of this section is to give the patentee an opportunity to make valid and operative

* This means Claims 1, 2 and 4; Claims 3, 5 and 6 are limited to a rounded end on one of the fingers, and are not in issue.

> that which was before invalid and inoperative; invalid, because it claimed as new that which had been previously invented or used by the public; inoperative, because the specification was defective or insufficient."

The present statute is the same in substance so far as the point here is concerned.

As pointed out on Page 15 of the Petition, Claims 1, 2 and 4, under the doctrine of differentiation of claims, cannot now have saving limitations read into them.

We respectfully submit that, respondent having artfully evaded declaring Claims 1, 2 and 4 to be invalid, it is for a Court to declare it for him.

As also pointed out on Page 15 of the Petition, it was and is respondent's purpose to cling to these three claims in order to prevent assertion of intervening rights on the part of defendant-petitioner.

In quoting the Title 35 statutes involved in the Appendix to the Petition, we quoted Section 252 in its entirety on Page 20. In respondent's brief, Page 3, the first paragraph of Section 252 is quoted, but the second paragraph of that section, having to do with intervening rights, is omitted.

Respondent's Argument with reference to the reissue aspects of the case begins near the bottom of Page 11 of its brief and opens with the following:

> "2. The question of whether the Patent Office had authority to allow narrower claims in the reissue is moot insofar as the ultimate result is concerned. For even if such claims should be found invalid, petitioner still infringes claims carried over from the original application which, under 35 U. S. C. 252, *supra*, p. 3, have effect continuously from the date of the original patent."

There is no question of whether the Patent Office had "authority" to allow narrower claims, assuming their subject matter is patentable. What we say is that, under the

statute, a patentee can not add narrower claims by reissue except by striking a broader claim or claims for invalidity.

And then respondent follows (Page 12) with the following remarkable statement:

> "But aside from the question of mootness, respondent is aware of no authority to the effect that additional claims of a narrower scope cannot be submitted in an application for a reissue patent without an admission by applicant that he was claiming more than he had a right to claim in the original patent. Nor has petitioner presented any such authority. Nor does inspection of 35 U. S. C. 251 and 252, or Rules 171-179, Rules of Practice of the United States Patent Office in Patent Cases, 35 C. F. R. §§ 1.171-1.179, disclose any prohibition such as that contemplated by petitioner. To the contrary, both the statutory provision and rules specifically refer to a situation where 'the claims of the original and reissued patents are identical'. 35 U. S. C. 252, *supra*, p. 3.
>
> "If any restriction such as suggested by petitioner was intended, it is only realistic to conclude that it would have been spelled out in the statutes and regulations in implementation thereof."

The theory of respondent seems to be that anything that is not specifically negatived by the reissue statute is permissible.

We submit that the statute (Sec. 251) is its own authority; hence our reference, on Page 10 of the Petition, to "the exacting limitations of the statute." Let us also refer to the *McCormick* v. *Aultman* case above mentioned, and the case of *General Radio Co.* v. *Allen B. Du Mont Laboratories*, 129 F. (2d) (C. C. A. 3rd) at Pages 613 and 614.

It would seem that respondent's stated position in this regard should be cited as another reason why the writ prayed for should be granted. If the decisions of the Courts below, finding all the claims in issue valid, original as well as added, were to be taken as approving the theory

of respondent, we foresee such *ex post facto* claim tailoring, by the reissue process, in many a patent case in the future.

Respondent, in closing *his* Argument 2 (Pages 12-13), takes issue with petitioner's contention that Claims 1, 2 and 4 are met by the cited prior patent art. He states that, apparently, petitioner overlooks the term "finger" in these claims; on the contrary, petitioner has pointed out (Pages 11 and 15) why the word "finger" alone can not be accepted as distinguishing from the Hornsby Figure 17 holder, and the same applies in respect of all the prior bridged element holders.

Petitioner's *second* question presented for review is as follows:

> "2. Twine holders of the prior art comprise one, two or three flat elements for cooperation with a pair of parallel twine entraining disks; of the two-element type, some have their outer longitudinal edges solidly bridged and some have them completely separated; of the three-element type, the prior art holders have their elements bridged. Is it patentable to omit the bridge from the three-element type, leaving the longitudinal edges of the elements completely separated as in the two-element type?"

As to this, on page 2 of his brief under "Questions Presented", respondent substitutes the following:

> "1. Whether respondent's patent for a twine holder was properly held valid by the trial court and court of appeals."

That is all-inclusive; we answer in the negative.

Respondent's "Statement", beginning near the bottom of page 3 and ending on page 8 of his brief, is replete with controversial and argumentative statements. Petitioner's "Statement of the Case," pages 3-9 of the Petition con-

tains neither, and we deem it appropriate to pass to respondent's Argument 1, pages 9-11 of his brief.

At the opening of the Reply Brief for Defendant-Appellant in the Court of Appeals, we said:

> "Although the patent in suit is the basis upon which plaintiff's case must rest, he pays scant attention to it in his brief. He takes the asserted patent claims as an accomplished fact and treats them as unassailable because the Examiner allowed them.
>
> "Defendant, on the other hand, considers the formulating processes of the two grants of controlling importance."

Although respondent moved the Court of Appeals to transmit to this Court certified copies of the Patent Office file histories of respondent's original patent and of the reissue patent, he has made no reference thereto in his brief in opposition.

At the outset of his Argument, page 9, respondent cites Rule 52 (a) of the Federal Rules of Civil Procedure, and also 35 U. S. C. 282, which he quotes on page 3 and which provides that a patent shall be presumed valid, and that the burden of establishing invalidity shall rest on a party asserting it. We have, of course, no quarrel with either of these items.

When the said presumption was invoked by the District Court, it was with the understanding that the International Harvester and New Holland separated-finger holders (Petition pages 5 and 6) had been taken into account by the Patent Office Examiner in allowing the claims (DA 108); and the Court of Appeals followed the District Court, but not on any basis that the Patent Office file histories established the fact (App. 27, Petition Page 12). We submit that the said file histories could be the only competent evidence that the Patent Office Examiner was apprised of those prior holders and had taken them into account; and those file histories are completely silent in that regard. These International Harvester and New Holland holders

are "the two-element type" with "their outer longitudinal edges" "completely separated", set forth in petitioner's statement of Question 2 for review.

Utility, improvement, public acceptance, and commercial success are to be taken into account in resolving doubts as to the presence of invention, but they count for naught, if there was clearly no invention in the first place.

Respondent's assertion that testimony revealed that when the three element web-back holders were tested the twine would break—is solely the testimony of England (Eng. App. 12) predicated entirely on a self-serving model made by England (Plaintiff's Exhibit 13). There is no finding of fact regarding any twine breakage by a web-backed holder in the trial court's decision, nor any reference thereto in the appellate court's opinion. The exact opposite is the testimony of Dr. Baldwin (DA 88-90) with regard to a Deere three element holder having the back edges bridged or welded together (Defendant's Exhibit 17). Also, the prior art and prior uses covering a 60 year span from 1885 to 1945, represented by Wilkinson, British 410/85 (January, 1885) Hornsby, British 11419/88 (Aug. 1888), Cooley U. S. 352,081 (Nov. 1886) and Massey-Harris 10 years of manufacture and sale in substantial quantities from 1935 to 1945 (Defendant's Exhibit 5E, page 14, Appendix to Brief for Defendant-Appellant), all employing three element web-backed twine holders, would never have come to pass if these web-backed twine holders had suffered from an inherent defect of breaking the twine. Still further, even if it should be admitted for the sake of argument, that the web-backing might possibly have had some tendency to break twine, it surely cannot be maintained that the mere elimination of the web-backing constituted invention, particularly in view of the elimination of the web-backing in the two-finger International Harvester and New Holland twine holders. From the viewpoint of the ordinary mechanic,

this was merely a manufacturing transition from the old days of making a large proportion of metallic articles in the form of castings, which because of their inherent brittleness had to be reinforced by backings, webs and the like, to the present day practice of making a large proportion of metallic articles in the form of stampings, which because of their greater ductibility do not need reinforcing webs, backings, etc.

It is submitted that the facts in the case at bar fail to meet the criteria of invention established by this Court (see cases cited on Pages 16-17 of the Petition).

Respondent presents his Argument 3 (Pages 13-14) with reference to *Crane Packing Co.* v. *Spitfire Tool and Machine Co.* referred to on Page 17 of the Petition. Respondent's point is that the facts in the instant case are distinguishable from the facts in that case, in that the added claims in respondent's reissue are narrower claims than those retained from the original patent. Respondent says that other distinctions also exist, but he does not specify them. He closes, however, by saying that it is moot here because "the original claims would remain valid and infringed"; and we have already treated of that subject above.

We respectfully submit that respondent's brief in opposition has shown no cause for denying the writ prayed for by petitioner, and that the writ should be granted as originally prayed.

Respectfully submitted,

ARTHUR H. BOETTCHER,
CAMERON A. WHITSETT,
EDWARD C. GRELLE,
Attorneys for Petitioner.

TWINE HOLDER

Original Filed Oct. 15, 1951

Fig. 1

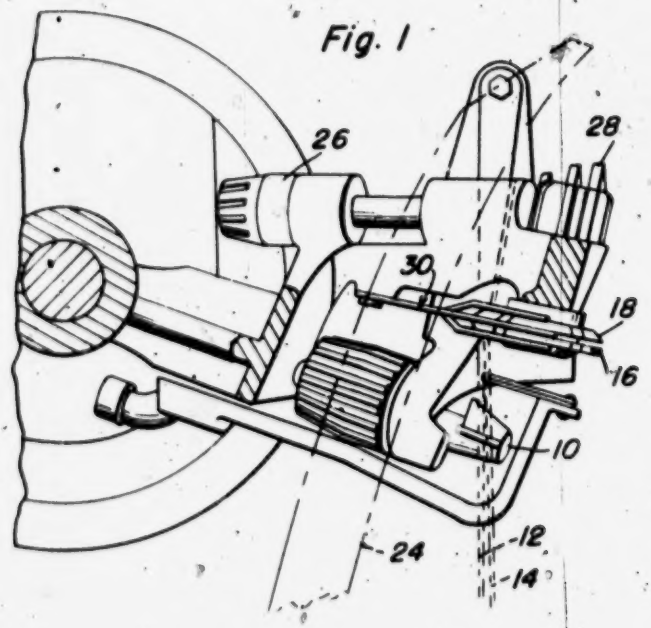


Fig. 4

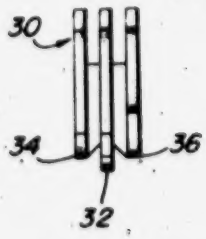


Fig. 2

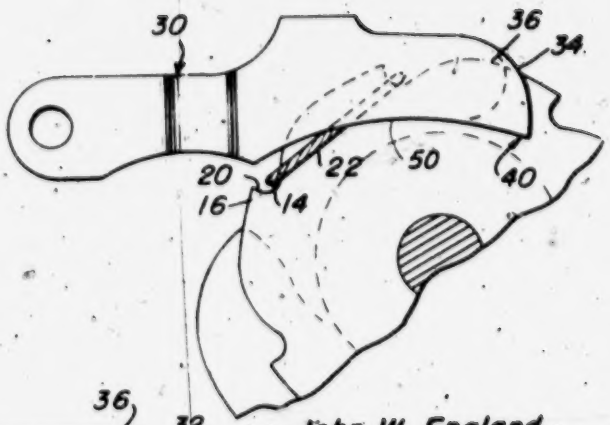
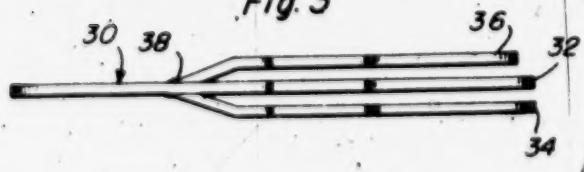


Fig. 3



John W. England

INVENTOR.

BY Thomas A. O'Brien and Harvey B. Jacobson

Attorneys

23,927

TWINE HOLDER

John W. England, Iowa Falls, Iowa

Original No. 2,594,140, dated April 22, 1952, Serial No. 251,407, October 15, 1951. Application for reissue September 23, 1954, Serial No. 458,724

12 Claims. (Cl. 289—14)

Matter enclosed in heavy brackets [ ] appears in the original patent but forms no part of this reissue specification; matter printed in italics indicates the additions made by reissue.

This invention relates to a twine holder and particularly to an improved device for retaining the twine within the twine entraining disk of knotting devices.

In the utilization of knot tying devices on such devices as reapers and haybalers, etc., it is customary to retain the cord or twine with which the bales or bundles are tied up in a twine entraining rotary disk in which a spring fastened finger assists in holding the cord or twine in the entraining disk. In heavy application, particularly in balers, difficulty is had because of the twine pulling out of the entraining disks, leaving loose bales when the same are dropped on the field.

The present invention provides a twine holder for cooperation with the twine engaging disk of the usual knotting device having sufficient twine engaging surface to prevent disengagement of the twine from the twine entraining disk. This is accomplished by providing, in addition to the usual central twine holding finger, a plurality of laterally spaced fingers extending over the outer circumference of the twine engaging disk so as to provide a plurality of twine engaging surfaces on the inner and outer sides of the twine engaging disk.

It is accordingly an object of this invention to provide an improved twine holder.

It is a further object of this invention to provide a twine holder having a plurality of fingers engaging both the inner and outer surfaces of the twine entraining disk. It is a further object of this invention to provide a twine holder having a plurality of fingers, one of which prereleases the twine from the twine engaging disk.

Other objects and many of the attendant advantages of this invention will be found in the following detailed description, taken in conjunction with the accompanying drawing, in which:

Figure 1 is a perspective view of a portion of a knotter showing the improved twine holder in place;

Figure 2 is an enlarged side elevation of the twine holder in place on a twine entraining disk;

Figure 3 is an enlarged top plan view of the twine holder; and

Figure 4 is an end view of the twine holder.

In the exemplary embodiment of the invention, a knotting device includes a periodically operable bill hook for forming knots in a pair of cords forming the ends of a loop around a bale of material (not shown). Adjacent to bill hook **10** is a pair of *spaced apart* twine entraining rotary disks **16** and **18**, *as shown in Figure 1*, having peripheral notches **20** therein for retaining the bight **22** of the twine **14**, said twine being presented to the peripheral notch **20** by means of a needle device **24**. When the cord **14** is drawn across the periphery of the disks **16** and **18**, the entraining wheels **16** and **18** are driven by an intermittent gear **26** by means of a worm **28** to advance the bight **22** under the pivoted twine holder **30**, after which the tying cords are cut off and the needle retreats to lay the track for another bale. It has heretofore been customary to use a twine holder having a single finger received in the space between the entraining wheels **16** and **18**. The present invention provides a twine holder arm **30** having a plurality of fingers including a central finger **32** which passes between or is received in the space between the entraining wheels **16** and **18** for the customary purpose of forcing the twine down in and between the disks where it is frictionally held. A pair of laterally spaced holding fingers **34** and **36** are rigidly attached to

the holder **30** by suitable means such as welding **38**. This pair of fingers **34** and **36** are parallel to and embrace the outer surfaces of the wheels **16** and **18** so that the twine is additionally held between the fingers **34** and **36** and the outer surface of the twine engaging wheels **16** and **18**. *As seen in Figures 1, 3 and 4, all of the longitudinal edges of said fingers are spaced from each other to provide completely open spaces betwen the fingers.*

The surface of the fingers **32**, **34** and **36** presented toward the periphery of the wheels **18** and **16** is provided with an arcuate engaging surface or edge **50** to facilitate the passage of the twine between the fingers and the gripping wheels. The fingers **32** and **34** are provided with hooked nose releases **40** for releasing the twine suddenly during the motion of the twine engaging wheels. However, the outside finger **36**, that is, the side furtherest removed from the knotting element, is provided with a rounded end to secure a pre-release of that twine that is still held by the needle and which will retreat to lay the new track for the coming bale.

In operation, the improved twine holder provides sufficient twine engaging surface to prevent the heavy operation from withdrawing the twine from the twine entraining disk.

While for purposes of illustration, a preferred embodiment has been shown and described according to the best present understanding thereof, it will be apparent that changes and modifications can be made therein, without departing from the true spirit of the invention.

Having described the invention, what is claimed as new is:

1. In a tying machine having a pair of spaced apart twine entraining rotary disks, said disks having peripheral twine receiving notches, said twine holder comprising an arm mounted adjacent the periphery of said disks, a central plate-like finger on said arm, said central finger extending between said disks, a pair of plate-like fingers rigidly secured in spaced parallel relation to said central finger, said pair of fingers lying adjacent the outer sides of said twine entraining disks.

2. In a tying machine having a pair of spaced apart twine entraining disks, said disks having peripheral twine receiving notches, a twine holder comprising an arm pivotally mounted adjacent the periphery of said disks, a central finger on said arm, said central finger extending between said disks, a pair of fingers rigidly secured in spaced parallel relation to said central finger, said pair of fingers engaging the outer sides of said twine entraining disks, the face of each of said fingers having an arcuate twine engaging surface or edge portion.

3. In a tying machine having a pair of spaced apart twine entraining disks, said disks having peripheral twine receiving notches, a twine holder comprising an arm pivotally mounted adjacent the periphery of said disks, a central finger on said arm, said central finger extending between said disks, a pair of fingers rigidly secured in spaced parallel relation to said central finger, said pair of fingers engaging the outer sides of said twine entraining disks, one of said fingers having a rounded end for initiating release of said twine.

4. A twine holder for use in a tying machine having a pair *of* step by step twine engaging disks; said twine holder comprising a supporting arm having means adjacent one end for pivotally mounting the same and having a plate-like central presser finger extending therefrom and a pair of plate-like fingers mounted in spaced relation to said first presser finger, said pair of fingers having their adjacent longitudinal edges in the form of arcs.

5. A twine holder for use in a tying machine having a pair *of* step by step twine engaging disks; said twine holder comprising a supporting arm having means adjacent one end for pivotally mounting the same and having a plate-like central presser finger extending therefrom and a pair of plate-like fingers mounted in spaced relation to said first presser finger, said pair of fingers having their adjacent longitudinal edges in the form of arcs, said first named presser finger and one of said pair of plate-like fingers being of substantially the same length and said other plate-like finger of said pair of fingers having a rounded end.

6. A twine holder for use in a [typing] *tying* machine having a pair *of* step by step twine engaging disks; said twine holder comprising a supporting arm having means adjacent one end for pivotally mounting the same and having a plate-like central presser finger extending therefrom and a pair of plate-like fingers mounted in spaced relation to said first presser finger, said pair of fingers having their adjacent longitudinal edges in the form of arcs, said first named presser finger and one of said pair of plate-like fingers being of substantially the same length and each having a hooked nose, and said other plate-like finger of said pair of fingers having a rounded end.

7. In a twine tying machine having a pair of spaced apart twine entraining rotary disks, said disks having peripheral twine receiving notches; the combination with said machine of a twine holder comprising an arm, arm pivot means for pivotally mounting said arm on said machine adjacent the peripheries of said disks, a central plate-like finger extending between said disks, a pair of plate-like fingers, means rigidly securing one end only of each of the fingers of said pair of fingers to said arm with one finger of said pair of fingers on each side of said central finger, the said fingers being completely separated from each other along all of their longitudinal edges and providing open spaces between said fingers whereby the said central finger may freely move between said disks during movements of said arm about said pivot means.

8. In a tying machine having a pair of spaced apart twine entraining disks, said disks having peripheral twine receiving notches; the combination with said machine of a twine holder comprising an arm, arm pivot means for pivotally mounting said arm on said machine adjacent the peripheries of said disks, a central finger on said arm, said central finger extending between said disks, a pair of fingers rigidly secured in spaced parallel relation to said central finger, said pair of fingers engaging the outer sides of said twine entraining disks, the face of each of said fingers having an arcuate twine engaging surface or edge portion, the said fingers being completely separated from each other along all of their longitudinal edges and providing open spaces between said fingers whereby the said central finger may freely move between said disks during movements of said arm about said pivot means, said central finger being integral with said arm.

9. A twine holder for use in a tying machine having a pair of spaced apart step by step twine engaging disks; said twine holder comprising a supporting arm having means adjacent one end for pivotally mounting the same on said tying machine and having a plate-like central presser finger extending therefrom and a pair of plate-like fingers mounted in spaced relation to said first presser finger, said pair of fingers having their adjacent longitudinal edges in the form of arcs, and means rigidly mounting said pair of plate-like fingers on said arm, the said fingers being completely separated from each other along the longitudinal edges of each finger.

10. A twine holder for use in a tying machine having a pair of spaced apart step by step twine engaging disks;

said twine holder comprising a supporting arm having means adjacent one end for pivotally mounting the same on said tying machine adjacent said disks, said twine holder having a plate-like central presser finger extending from said arm and forming an integral part thereof and a pair of plate-like fingers, means rigidly mounting said pair of plate-like fingers on said arm in parallel relation to each other and to said central presser finger, said last named means comprising the sole attachment for said pair of plate-like fingers to said arm whereby to provide open spaces between said fingers, all of said fingers having certain of their adjacent longitudinal edges in the form of arcs and their other edges spaced from each other.

11. A twine holder for use in a tying machine having a pair of spaced apart step by step twine engaging disks; said twine holder comprising a supporting arm having pivot means adjacent one end for pivotally mounting the same and having a plate-like central presser finger extending therefrom and a pair of plate-like fingers mounted in spaced parallel relation to said first presser finger, said pair of fingers having their adjacent longitudinal edges in the form of arcs, and means rigidly mounting said pair of plate-like fingers on said arm in parallel relation to each other and to said central presser finger, the said fingers being completely separated from each other along both longitudinal edges of each finger, whereby to provide open spaces between said fingers and to provide open ends opposite to said arm pivot means.

12. A twine holder for use in a tying machine having a pair of spaced apart step by step twine engaging disks; said twine holder comprising a supporting arm having pivot means adjacent one end for pivotally mounting the same and having an integral plate-like central presser finger extending therefrom and a pair of plate-like fingers mounted in spaced parallel relation to said first presser finger, said pair of fingers having their adjacent longitudinal edges in the form of arcs, and means rigidly mounting said pair of plate-like fingers on said arm in parallel relation to each other and to said central presser finger, the said fingers being completely separated from each other along both longitudinal edges of each finger, whereby to provide open spaces between said fingers, and to provide open ends opposite to said arm pivot means.

References Cited in the file of this patent or the original patent

UNITED STATES PATENTS

314,056	Remy	Mar. 17, 1885
345,674	Colley	July 20, 1886
352,081	Colley	Nov. 2, 1886

FOREIGN PATENTS

410	Great Britain	1885
11,419	Great Britain	1888
497,474	Great Britain	Dec. 20, 1938